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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/037,017

12/21/2001

Yeh-Hung Lai

83648MGB

5674

7590

05/05/2004

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 05/05/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,017

Applicant(s)

LAI ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,9 and 19-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7,8,10,11 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Species A in Paper No. 11 is acknowledged.
2. Claims 4, 6, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in Paper No. 11. Claims 4 and 6 were withdrawn due to the fact that they deal with a second crack initiator on a second cutter with is part of non-elected Species B.

***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 2 line 15 of the "please replace the paragraph beginning on Page 12 line 17" in the amendment filed on 14 November 2003, item "94". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities: On page 2 line 16 of the "please replace the paragraph beginning on Page 12 line 17" in the amendment filed on 14 November 2003, the phrase "The low rake cutter base 104" should be replaced with "The low rake cutter base 94".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 5, 7, 8, 10, 11, and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In regards to claim 1, step (e), "further propagating the first crack using a rake edge of the cutter base, thereby disengaging the first crack initiator of the first cutter from contact with the sheet metal", is unclear. It is uncertain how the first crack initiator can be disengaged from the work piece when the cutter base is still cutting.

8. In regards to claim 3, the phrase "generating a second crack in the second side of the sheet material with the second cutter" is unclear. Using Figure 2, it is uncertain how the second cutter generates a crack without a crack initiator.

9. Claims 5, 15, and 16 recite the limitation "the laminated web structure" on line 3 in all the claims. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 7, 8, 10, 11, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fruit.

Fruit discloses the same invention including engaging a first side of the sheet metal with a first crack initiator having a high rake angle (12), that the crack initiator extends from a first cutter base having a low rake angle (10), simultaneously engaging a second side of the sheet material with a second cutter (13), generating a first crack in the first side of the sheet material with the first crack initiator (Fig. 2), engaging the sheet material with the cutter base of the first cutter by moving the first cutter perpendicular to the sheet material (10), further propagating the first crack using a rake edge of the cutter base, thereby disengaging the first crack initiator of the first cutter from contact with the sheet metal (Fig. 2), continuing to propagate the crack through to the second side of the sheet material using a rake edge of the cutter base (Fig. 2), generating a second crack in the second side of the sheet material with the second cutter (Fig. 2), that the first and second cracks intersect (Fig. 2), that the high rake angle of the first crack initiator is in the range of from about 45°-to about 70° (12), that the crack initiator has a relief angle greater than 0° and not more than about 30° (12), and that the cutter base of the first cutter has a relief angle of not more than 30° (10).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fruit in view of Camp et al. Fruit discloses the invention including that the first

Art Unit: 3724

crack initiator has a height and is at least 20  $\mu\text{m}$  (12) but fails to disclose that the height is greater than a thickness of a protective coating on the first side of the laminated web structure. Camp et al teaches that the height is greater than a thickness of a protective coating on the first side of the laminated web structure (25). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Fruit with a first crack initiator that has a height greater than a thickness of a protective coating, as taught by Camp et al., to allow the crack initiator to penetrate through a coating as well as the sheet material.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/037,017

Page 6

Art Unit: 3724

A handwritten signature, possibly reading 'JP', in black ink.

JP

April 28, 2004

A handwritten signature, possibly reading 'ay', in black ink.

Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700